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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,170	05/23/2000	Paul Lapstun	NPX011US	9181

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AUSTRALIA

EXAMINER

ABDULSELAM, ABBAS I

ART UNIT PAPER NUMBER

2674

DATE MAILED: 02/23/2005

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,170

Applicant(s)

LAPSTUN ET AL.

Examiner

Abbas I Abdulsalam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,21-36,42,43,48-65,73-87,92,93 and 112 is/are rejected.
- 7) ☒ Claim(s) 10-20,37-41,44-47,66-72,88-91 and 94-111 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see # 8, filed 10/10/02, with respect to the rejection of claims 1-112 under U.S.C. (103) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Comerford (USPN 5243149).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 21-36, 42-43, 48-65, 73-87, 92-93 and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comerford (USPN 5243149).

Regarding claims 1, 29, 56, 79 and 112, Comerford teaches as shown FIGS. 1 and 2 a the digitizing tablet 10 and the scanner 15, which is removable and is used for scanning the surface of objects. Comerford teaches that the digitizing tablet (10) includes a surface, and its components are shown in Fig 10, which includes a stylus digitizer (210) and scanner interface (206).

Comerford illustrates as shown on Fig. 13 a document D, which carries some original text and/or graphics as well as an ID in the form of a bar code. Comerford shows an action of the scanner traversing the document and generating scan signals, and the original text and graphics being

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captured in the file scan 113(col. 8, lines 33-64). Comerford teaches software functions as shown in Fig 11 including capturing image by a scanner (S1), capturing stylus motion (D1) by a digitizer and performing to write to the control file to provide the link between the scanned file and a tablet file by function D3.

Comerford has been described. However, Comerford does not specifically disclose the use of “coded data indicative of a text field”. However, as mentioned above, Comerford teaches components internal to the tablet (10) (col. 6, lines 17-18) including a CPU (201) and stylus digitizer (210)). Comerford teaches that the user can add several handwritten annotations on the document such as annotation N1-N3 as shown in Fig. 13B creating tablet signals from a digitizer (210) that would be employed by the CPU (201) to create a file DIGITIZE to be stored on the disk contained in the disk drive (209). See col. 8, lines 65-68 and col. 9, lines 1-6. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Comerford’s creation of tablet signals in conjunction with CPU (201) and stylus digitizer (210) (Fig. 10) for the purpose of assigning codes and what they stand for on the tablet.

In response a feature in the claims that states “a movement data, the movement data being indicative of the sensing device movement relative to the interface surface”, Comerford teaches that a bar code is scanned in and the data encoded in it is used to prepare a file header for the data reflecting that page. Comerford further teaches that as the user makes annotations or adds text in handwriting, the digitizer generates data describing the stylus motion; that data is gathered and stored with a link to the scanned image. See col. 3, lines 34-38.

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Regarding claims 5-9, 32-35, 59-63 and 83-87, Comerford teaches new versions of a document may be created either by conventional editing of coded information or by NCI editing of the document images. See col. 3, lines 11-14.

Regarding claim 80-81, Comerford teaches recorded data in terms of recreation through printing or for reduction to coded form through a combination of recognition software techniques, e.g. optical character recognition for printed or typed text and handwriting recognition for written annotations. See col. 2, lines 59-66.

Regarding claims 2-4, 21-28, 30-31, 36, 42-43, 48-55, 57-58, 64-65, 73-78, 82 and 92-93, as mentioned above, Comerford shows an action of the scanner traversing the document and generating scan signals, and the original text and graphics being captured in the file scan 113(col. 8, lines 33-64). Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Comerford's CPU (201) and stylus digitizer (210) as configured in Fig. 10 for the manner by which the tablet is configured.

Allowable Subject Matter

3. Claims 10-20, 14, 37-41, 44-47, 66-69, 70-72, 88-91 and 94-111 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Abbas Abdulsalam** whose telephone number is **(703) 305-8591**. The examiner can normally be reached on Monday through Friday (9:00-5:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Patrick Edouard**, can be reached at **(703) 308-6725**

Any response to this action should be mailed to:

Commissioner of patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314

Hand delivered responses should be brought to Crystal Park II, Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology center 2600 customer Service office whose telephone number is (703) 306-0377.

Abbas Abdulsalam

Examiner

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January 29, 2005


XIAO WU
PRIMARY EXAMINER